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In re Application of: :  
Seiller et al. :  
Serial No.: 10/578,765 : PETITION DECISION  
Filed: March 20, 2007 :  
Attorney Docket No.: MERZ 49 PCT US :

This is in response to the petition under 37 CFR § 1.181, filed March 2, 2009, requesting that the finality of the Office action of December 4, 2008 be withdrawn.

#### BACKGROUND

On December 18, 2007, the examiner mailed to applicants a restriction requirement, wherein applicants were required to elect a single active compound specie and a single disclosed composition.

On February 14, 2008, applicants elected neramexane and preservative free composition.

On May 21, 2008, the examiner mailed a non-final Office action in which the restriction requirement was made final. Claims 8-11, 23-25, 27-32, 42-43, and 45-55 were withdrawn by the examiner as being drawn to a nonelected species. Claims 17-22 were objected to under 37 CFR 1.75(c) for being in improper dependent form and claim 44 was objected to for informalities. Claims 22 and 44 were rejected under 35 USC 112, second paragraph, as being indefinite. Claims 1-3, 6-7, 12, 14-22, and 39-40 were rejected under 35 USC 102(b) as being anticipated by Parsons et al. (WO 01/98253 A2); claims 1, 4-5, and 39-41 were rejected under 35 USC 103 (a) as being unpatentable over Parsons et al.; and claims 1, 13, 26, and 44 were rejected under 35 USC 103(a) as being unpatentable over Parsons et al. and Gupta et al. (US 2005/0014743 A1).

On August 18, 1008, applicants submitted an amendment, in which claims 8-12, 33-38, 42-43, and 46-47 were canceled. Claims 1-3, 5-7, 13-14, 17, 20, 26, 39, and 44 were amended. Applicants also provided remarks traversing the objections and rejections.

On December 4, 2008, the examiner mailed a final Office action. Claim 44 was objected to due to informalities. Claims 1-3, 6-7, 14-22, and 39-40 were rejected under 35 USC 102(b) as being anticipated by Parsons et al.; claims 1, 4-5, and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parsons et al.; and claims 1, 13, 26, and 44 were rejected under 35 USC 103(a) as being unpatentable over Parsons et al. and Gupta et al.

On March 2, 2009, applicants submitted as response, including the petition under review, amendments to the claims, and remarks traversing the objection and rejections.

## DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicants argue that the final Office action mailed December 4, 2008 incorrectly set forth that no arguments had been presented regarding the rejection of claims 1, 4-5, and 39-41 under 35 USC 103(a) as being unpatentable over Parsons et al. This is persuasive.

Applicants also argue the merits of the rejections under 35 USC 103(a), including a discussion of unexpected results and correction of a typographical error in Table 7. However, these issues will be left to the consideration of the examiner, who is in the best position to consider the totality of the evidence.

## DECISION

The petition is **GRANTED**.

The Office action mailed December 4, 2008 is hereby vacated. The application is being returned to the examiner for consideration of the amendment submitted March 2, 2009, specifically to address the arguments submitted by applicants regarding Parsons et al. alone or in combination with the Gupta et al.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



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